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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,067

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Jonathan J. Hull

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20350

7590

10/03/2006

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,067

Applicant(s)

HULL ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 20-32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2006 has been entered.

### ***Response to Arguments***

Applicant's arguments, see page 6, filed July 17, 2006, with respect to rejection of claims 25-32 under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive. The rejection of claim 25-32 under 35 U.S.C. 112, first paragraph has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25, 26, 27, 29, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd (US Patent No. 5,890,163) in view of Rice et al (US Patent No. 6,411,947).

Concerning claims 25, 27, 29 and 31, Todd discloses an email server (col. 4, lines 32-34) for performing unconscious archiving of electronic document in a network environment (col. 2, lines 7-30) wherein electronic documents are transferred over a network (Fig.2) coupling at least one client computer (20) and at least one document management workstation (26) having at least one database (50) disposed to receive electronic copies of the documents for archiving (col. 2, lines 7-30), the server operatively disposed to collect electronic image data of an email document transmitted over the network (Fig.1), wherein the email document was transmitted in response to a single user input command (col. 2, lines 17-22) configured to transmit the email document to a destination, the electronic image data being a copy of the email document transmitted over the network (col. 2, lines 7-30); cause said image data to be stored in the at least one database to perform the unconscious capture archiving (col. 2, lines 7-30), wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command for transmitting the email document to a destination, wherein the storing of the image data in the at least one database is separate from the transmission of the email document to the destination (the storage occurs after transmission of the email), (col. 2, lines 7-30).

Todd does not directly teach that the unconscious capture archiving is performed transparent to the user. Rice et al discloses an automatic message interpretation and routing system (Fig.1) including an archive (32) in the auto message reader 30. From Fig.1, a plurality of customers 50 (users) transmits electronic messages 11 to the automatic message interpreting and routing system 1 via source computers 52 coupled to the domain server 10. The automatic message reader 30 in the system 1 includes an archive 32 (database) for storing the electronic messages, which is transparent to the customers 50 (col. 4, lines 1-19; col. 9, lines 24-29). Rice

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further teaches, “all outgoing responses are archived in an archive database 32 for subsequent review and use if desired.” (col. 10, lines 48-50). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of storing of the electronic messages and responses for archiving in Rice to Todd since Todd also teaches that the data files of the converted email messages can be stored on the client computer’s local storage device 34 or on the data processing server’s network storage device 32 (col. 4, lines 15-25).

Concerning claims 26 and 30, Todd discloses a destination client system (Fig.1; col. 1, lines 52-63).

3. Claims 20, 21, 22, 23, 24, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of Rice and Bellemare et al (US Patent No. 5,701,183).

Concerning claims 20, 21, 22, 28 and 32, Todd in view of Rice discloses an email server as discussed in claims 25-27, 29-31 above. Todd in view of Rice differs from claims 20, 22, 28 and 32 in that he does not clearly disclose that the database comprises image data from a copy, print or facsimile function. Bellemare discloses an apparatus for the selective archiving of facsimile messages (col. 4, lines 24-56). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have modified Todd to store images from a copy, print or facsimile function as taught in Bellemare in order to obtain a variety of image data in the database since a copy, print or facsimile message can be transmitted and received in email format.

Concerning claims 23 and 24, Todd discloses storing addresses for the email (col. 5, lines 12-37); and storing a transmission data of the email (col. 7, lines 24-32, col. 9, lines 4-7).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Merriam (US Publication No. 2003/0208608) discloses an e-mail list archiving and management with an automated manager for an electronic mail archive repository.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2625

September 28, 2006